



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/426,896	10/26/99	IMANAKA	35.C13949

005514 MM91/0813
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112

EXAMINER

YOCKEY, D

ART UNIT

PAPER NUMBER

2861

8

DATE MAILED: 08/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/426,896

Applicant(s)

IMANAKA ET AL.

Examiner

David Yockey

Art Unit

2861

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-67 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☒ Other: *Diagram of Claim Dependencies*.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-67 are rejected for being unduly multiplied, as an unreasonable number of claims in view of the nature and scope of Applicants' invention and the state of the art have been presented for examination. See MPEP 2173.05(n). As set forth by *In re Chandler*, 254 F.2d 396, 117 USPQ 361 (1958) and *In re Chandler*, 319 F.2d 211, 225, 138 USPQ 138, 148 (1963), Applicant's latitude in stating their claims in regard to number and phraseology employed "should not be extended to sanction that degree of repetition and multiplicity which beclouds definition in a maze of confusion." As demonstrated by the attached diagram of claim dependencies including all multiple dependencies, such a maze of confusion is clearly present in the instant application.

After careful consideration of the claims presented, it is the opinion of the Examiner that the invention could be properly defined in under 40 claims. This reasoning is based upon findings that 1) many claims substantially duplicate other claims with the only substantive difference being that one set is directed to a head substrate and another is directed to a printing head, while head substrate claims also

include dependant claims covering such a printing head; 2) chains of claims are unnecessarily presented with multiple dependencies stemming from highly redundant claims with minor variations; 3) subject matter in large number of claims including recitations pertaining to the writing inhibition means could easily be presented as a small number of dependant claims providing further limitation in this regard.

Each dependency of a multiple dependant claim is a distinct claim in its own right; accordingly, the instant application is understood to include 212 claims. While it is the opinion of the Examiner that the invention could be properly defined in under 40 claims, in order to allow Applicants latitude in stating their claims in regard to number and phraseology employed, 60 claims is not considered to be an unreasonable number of claims.

A telephone call was made to Joseph Ragusa (Reg. No. 38586) on 9 August 2001, but no selection of claims was made.

Applicant is required to select 60 claims for examination, where, as noted above, each multiple dependency is considered as a distinct claim or, if desired, to present amendment limiting the number of claims, including those resulting from multiple dependency, to 60.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Yockey whose telephone number is (703) 308-3084. The examiner can normally be reached on weekdays.

Art Unit: 2861

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, N. Le can be reached on (703) 308-0750. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3431 for regular communications and (703) 305-3431 for After Final communications.

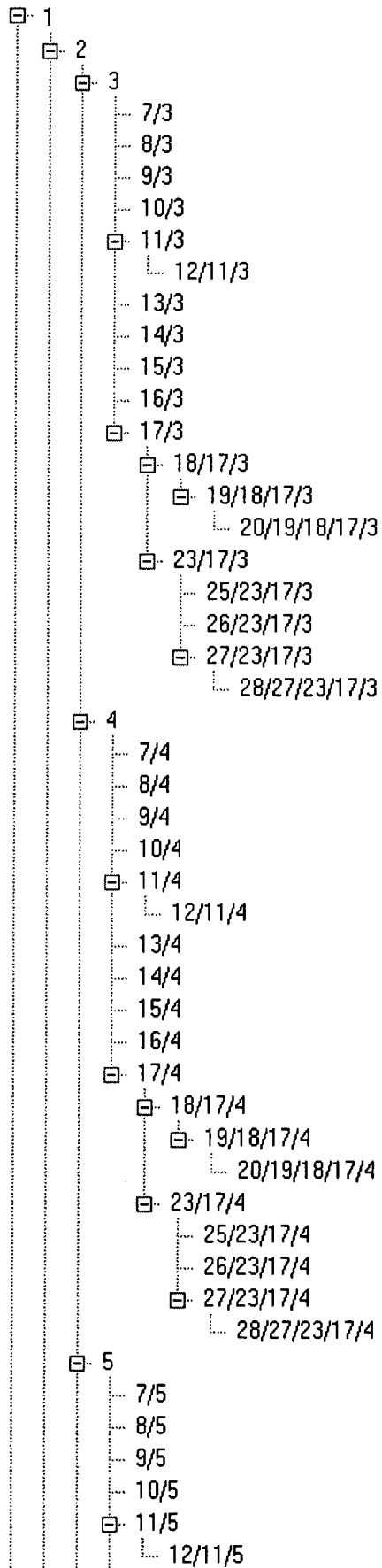
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DAVID F. YOCKEY
PRIMARY EXAMINER

DY
August 11, 2001

Diagram of Claim Dependences

Attachment to
Paper # 8

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